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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,218	12/28/2000	Darwin A. Engwer	003239.P067	9343
8791	7590	11/09/2004	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD SEVENTH FLOOR LOS ANGELES, CA 90025-1030			KADING, JOSHUA A	
			ART UNIT	PAPER NUMBER
			2661	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

6X

<b>Office Action Summary</b>	<b>Application No.</b> 09/753,218	<b>Applicant(s)</b> ENGWER ET AL.	
	<b>Examiner</b> Joshua Kading	<b>Art Unit</b> 2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7-11, 13-15, 17, 18 and 20 is/are rejected.
- 7) ☒ Claim(s) 2, 16, and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

Claims 1 and 17 are objected to because of the following informalities:

Claim 1, line 10 states "determining if it". For clarity, "it" should be changed to

5 --said wireless unit--.

Claim 17, line 2 states "first and second sub-networks data coupled". This doesn't seem to make sense. It is suggested line 2 be changed to --first and second sub-networks coupled--.

Claim 19, line 2 states "said sub-network". For clarity, this should be changed to

10 --said second sub-network--.

Appropriate correction is required.

Claims 2, 16, and 19 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

15 Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 2 states "said information comprises a network protocol address of said second access point". However, currently amended claim 1 states this very limitation on lines 6-7.

20 Claim 16 states "said information further comprises a subnet mask of said second sub-network". However, currently amended claim 15 states this very limitation.

Claim 19 states "said information comprises a subnet mask of said second sub-network". However, currently amended claim 17 states this very limitation on lines 8-9.

***Claim Rejections - 35 USC § 102***

5           The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

          Claims 7-10, 17, 18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (U.S. Patent 6,535,493 B1).

10           Regarding claim 7, Lee discloses "a wireless unit for communicating with a wired backbone network having first and second sub-networks by way of respective first and second access points (figure 1), comprising: a wireless transceiver to communicate with said first and second access points via a wireless medium (figure 2A, element 220); a memory to communicate current network protocol address valid for said first

15   sub-network (figure 2A, element 202; col. 8, lines 21-26 where the first sub-network is defined by the home agent address stored in the mobile unit's memory); and a logic circuit to receive a message from said second access point by way of said wireless receiver (figure 2A, element 200), said message includes information from which said logic circuit can determine if said current network protocol address is valid for said

20   second sub-network (col. 8, lines 21-40 where the message sent by the AP is used by the mobile to determine if the current associated address is valid for the sub-network serviced by the AP), said logic circuit is adapted to transmit a request for a new network

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protocol address valid for said second sub-network if said logic circuit determines if said current network protocol address is not valid for said second sub-network and determine if said new network protocol address has been previously stored in said memory (col. 8, lines 41-53 whereby determining by the mobile, if the an advertisement  
5 has been received is equivalent to determining if the address has been previously stored because they both alert the mobile to the fact that the AP has already been identified and there is no need for a further request of identity), and transmitting said request for said new network protocol address if said new network protocol address has not been previously stored in said memory (col. 8, lines 42-47)."

10

Regarding claim 8, Lee discloses "the wireless unit of claim 7, wherein said information comprises a network protocol address of said second access point (col. 8, lines 45-47 where col. 5, line 53 indicates an address of the access point)."

15

Regarding claim 9, Lee discloses "the wireless unit of claim 7, wherein said information comprises a subnet mask pertaining to said second sub-network (col. 8, lines 21-28)."

20

Regarding claim 10, Lee discloses "the wireless unit of claim 7, wherein said logic circuit is capable of transmitting a request to release said current network protocol address (figure 3, element 312)."

Regarding claim 17, Lee discloses "a wireless network system, comprising: a wired backbone network comprising first and second sub-networks coupled together by way of a network device (figure 1, where each AP 104 and 132 represent a separate sub-net of each LANs 110 and 120, each are connected by network devices 114 and 144); a first access point on said first sub-network (figure 1, element 104); and a second access point on said second sub-network (figure 1, element 132), comprising a logic circuit for transmitting a message to one or more wireless units (figure 1 where each AP is capable of transmitting to the wireless units 100 and 130), said message includes information from which a wireless unit can determine if a current network protocol address assigned to said wireless unit is valid for said second sub-network (col. 8, lines 21-40 where the message sent by the AP is used by the mobile to determine if the current associated address is valid for the sub-network serviced by the AP), said information includes a network protocol address for said second access point and a subnet mask of said second sub-network (col. 5, line 53 indicates an address of the access point and col. 8, lines 21-28)."

Regarding claim 18, Lee discloses "the wireless network system of claim 17, wherein said information further comprises a Media Access Control (MAC) address of said second access point (col. 5, line 53)."

Regarding claim 20, Lee discloses "the wireless network system of claim 17, wherein said message further includes information which said one or more wireless units can make roaming decision based on (col. 8, lines 21-40)."

5

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, 4, and 11 are rejected under 35 U.S.C. 103(a) as being  
10 unpatentable over Lee et al. in view of Kobayashi et al. (U.S. Patent 5,724,346).

Regarding claim 1, Lee discloses "in a wireless network system comprising first and second sub-networks having respective first and second access points, and a wireless unit associated with first access point and having a current network protocol  
15 address valid for said first sub-network (figure 1), a method for said wireless unit to obtain a new network protocol address valid for said second sub-network, comprising: said wireless unit receiving a message having information, including a network protocol address of said second access point (col. 8, lines 21-40 and col. 5, line 53 indicates an address of the access point), from which said wireless unit can determine if said current  
20 network protocol address is valid for said second sub-network (col. 8, lines 21-40 where the message sent by the AP is used by the mobile to determine if the current associated address is valid for the sub-network serviced by the AP); said wireless unit determining

that said current network protocol address is not valid for said second sub-network from, said information by determining if said wireless unit has previously stored said network protocol address (col. 8, lines 41-53)...(ii) determining that said current network protocol address is not valid for said second sub-network if said wireless unit has not previously  
5 stored said network protocol address (col. 8, lines 21-40 whereby having to register with a new AP, the mobile unit has determined that the address has not been previously stored); said wireless unit associating with said second access point for communicating with said second sub-network (col. 8, lines 32-35); said wireless unit sending a request for said new network protocol address to said second sub-network by way of said  
10 second access point (figure 3, element 312); and said wireless unit receiving said new network protocol address from said second sub-network by way of said second access point (col. 8, lines 64-col. 9, lines 1-8)."

However, Lee lacks what Kobayashi discloses, "... (i) determining that said current network protocol address is not valid for said second sub-network based on  
15 information associated with said previously stored network protocol address (col. 12, lines 16-21 where the management table located in the mobile unit stores status indicators associated with APs, which include "connection impossible" or an indication the address is invalid)..."

It would have been obvious to one with ordinary skill in the art at the time of  
20 invention to include the determining validity of an address based on previously stored information for the purpose of attempting connections with valid APs. The motivation for



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doing this is to attempt to connect to the best possible AP, this will give the best possible connection (Kobayashi, col. 13, lines 25-30).

Regarding claim 3, Lee and Kobayashi disclose the system of claim 1. However,

5 Kobayashi lacks what Lee further discloses, "wherein said information comprises a subnet mask pertaining to said second sub-network (col. 8, lines 21-28)." It would have been obvious to one with ordinary skill in the art to include the subnet mask for the same reasons and motivation as in claim 1.

10 Regarding claim 4, Lee and Kobayashi disclose the system of claim 1. Although Lee lacks the additional status information that Kobayashi discloses, both Lee and Kobayashi further disclose "said wireless unit sending a request to release said current network protocol address to said first sub-network (Lee, figure 2, element 312; Kobayashi, figure 9, element 113)." It would have been obvious to one with ordinary skill  
15 in the art to include the release request for the same reasons and motivation as in claim 1.

Regarding claim 11, Lee discloses the wireless unit of claim 7. However, Lee lacks what Kobayashi discloses, "wherein said logic circuit is capable of determining if  
20 said new network protocol address has been previously stored in said memory, and determining whether said now network protocol address is valid based on information stored in said memory that is associated with said previously stored new network

protocol address (col. 12, lines 16-21 where the management table located in the mobile unit stores status indicators associated with APs, which include "connection impossible" or an indication the address is invalid)..."

5 It would have been obvious to one with ordinary skill in the art at the time of invention to include the determining validity of an address based on previously stored information for the purpose of attempting connections with valid APs. The motivation for doing this is to attempt to connect to the best possible AP, this will give the best possible connection (Kobayashi, col. 13, lines 25-30).

10 Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al.

Regarding claim 13, Kobayashi discloses "an access point, comprising a logic circuit for...one or more wireless units without any predetermination by the access point  
15 that a wireless unit has moved to a different sub-network (col. 15, lines 11-16 whereby the access point makes no determination as to the movement of the mobile, this is done by the mobile as read further in col. 15, lines 16-20); wherein said message includes information from which said one or more wireless units can determine if a current network protocol address is valid on the sub-network which said access point is on (col.  
20 13, lines 56-col. 14, lines 1-5 where the address identifying the address point is used in conjunction with the management table database to determine the validity of the addresses of each access point)."

However, Kobayashi does not explicitly disclose "periodically transmitting a message" from the access point to the wireless unit. Although Kobayashi does not explicitly disclose that the access point periodically sends messages to the wireless unit, it would have been obvious to one with ordinary skill in the art at the time of invention that the access point will inherently transmit data to the wireless unit. The motivation to send messages to the wireless unit is to communicate messages to the wireless unit from the network and vice versa.

Regarding claim 14, Kobayashi discloses the access point of claim 13. Although Kobayashi explicitly lacks the periodically transmitting of a message, Kobayashi further discloses "wherein said information comprises a network protocol address for said second access point (figure 7, element PAD where the table must be filled in through the transmission of addresses from the access points)." It would have been obvious to one with ordinary skill in the art to include the second access point address for the same reasons and motivation as in claim 13.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. in view of Lee et al.

Regarding claim 15, Kobayashi discloses the access point of claim 13. However, Kobayashi lacks what Lee discloses, "wherein said information comprises a subnet mask of said second sub-network (col. 8, lines 21-28)." It would have been obvious to one with ordinary skill in the art at the time of invention to include the subnet mask for

the purpose of determining the home subnet. The motivation for determining the home subnet is to determine if the mobile is roaming or not and take appropriate action as the roaming status of the mobile directly effects communication.

5

***Response to Arguments***

The objections to claims 21 and 23 have been withdrawn in light of the cancellation of claims 21-24.

10

Applicant's arguments with respect to claims 1-9, 11, and 12-20 have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Kading whose telephone number is (571) 272-3070. The examiner can normally be reached on M-F: 8:30AM-5PM.

15

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

- 5 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joshua Kading  
Examiner  
Art Unit 2661

10 November 3, 2004



BOB PHUNKULH  
PRIMARY EXAMINER